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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,869	08/23/2001	Jose Garcia Arumi	ARUMI	9449

7590 09/23/2003  
Ursula B. Day  
350 Fifth Avenue, Suite 3220  
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EXAMINER

BAXTER, JESSICA R

ART UNIT	PAPER NUMBER
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3731

6

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/935,869

Applicant(s)

ARUMI ET AL.

Examiner

Jessica R Baxter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-11,15 and 16 is/are rejected.
- 7) ☒ Claim(s) 8, 12-14 and 17-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 7 was objected to because of minor informalities. Correction is noted and the objection is withdrawn.
2. As stated in the previous office action, Claim 12 is objected to because of the following informalities: change "smaller than then the inside width" in line 3 to --smaller than the inside width--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. Claim 6 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Correction is noted and the rejection is withdrawn.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 7, 9, 10, 11, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent no. 5,222,973 to Sharpe et al.

Regarding claims 1, 7, 15 and 16, Sharpe discloses an instrument comprising a housing configured as a handle (14) and a functional unit disposed thereon and an actuator supported within the housing in operative engagement with a sliding pin and connected with the functional unit (12); and a tube shaped probe (11), which extends into a head piece and is movable in an axial direction relative thereto for operative engagement with the functional unit (12); and a rod co-axially supported within the probe configured as a grasping element (12) and having two arms separated by a slot (FIG. 3), the two arms are configured with distal end portions which are substantially transverse to the longitudinal axis and delimiting a recess opposing one another and are movable relative to one another into an elastic pre-tensioning first position wherein both arms are spread apart (FIG. 2) and a second position wherein the end portions terminate into opposing end faces (FIG. 3). Which when both arms are pressed together form a flush closure such that the two opposing recesses are formed together into a common recess for freely retaining and holding micro structures without squeezing or pinching the microstructures (Column 3 lines 22-29), and wherein the two arms starting from the cylindrical rod in the direction of the frontal face of the head piece are tapered off with opposing outside walls of the taper configured in one of a straight or arcuate shape (FIG. 3).

Regarding claim 9, Sharpe discloses that the recess of each of the arms starting from a frontal leg thereof in direction of the slot is arcuately shaped such that in a closed position the common recess has the shape of a tear drop (FIG. 3).

Regarding claim 10, Sharpe discloses that an inside length of the tear drop shaped recess is greater than the inside width of the tear drop shape (FIG. 3).

Regarding claim 11, Sharpe discloses that the recess of each of the arms each starting from a frontal leg thereof in axial direction of the slot is arcuately shaped such that in a closed position the common recess has an elongated shape (FIG. 3).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sharpe et al. '973 in view of U.S. Patent No. 5,746,770 to Zeitels et al.

Sharpe discloses the claimed invention except for the light guide projecting from the probe and configured as an optical lens. Zeitels teaches that a light guide is provided in a grasping instrument in order to directly illuminate the area in which the surgeon is working (Column 2 line 66-Column 2 line 25 and Column 4 line 53-Column 4 line 9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Sharpe with the light guide of Zeitels in order to directly illuminate the surgical site.

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***Allowable Subject Matter***

8. Claim 8, 12, 13, 14 and 17-20 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

9. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica R Baxter whose telephone number is 703-305-4069. The examiner can normally be reached on M-F 8:30AM - 5:00PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on 703-308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9302 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Jessica R Baxter  
Examiner  
Art Unit 3731

  
Jrb

September 21, 2003

  
MICHAEL J. MILANO  
SUPERVISORY PATENT EXAMINER  
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